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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,130	07/28/2003	Kung Peng-Chen	MT-001	3088
26250	7590	10/05/2004	EXAMINER	
FRANCIS EDWARD MARINO 394 MEREDITH NECK ROAD MEREDITH, NH 03253			PICKETT, JOHN G	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/628,130

Applicant(s)

PENG-CHEN, KUNG

Examiner

Gregory Pickett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/28/03.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the plurality of ejectors and the corresponding structures in claims 15-19 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 and 8 rejected under 35 U.S.C. 102(b) as being anticipated by Blase (US 5,425,451).

Regarding claim 1, Blase discloses a case **10** comprising a first and second **12** & **16** sidewalls of rectangular configuration having a top wall, bottom wall, rear wall, and opening as claimed (see Figure 8), and an ejector **20** with a rear arm and front arm as claimed (see Figure 8). Blase functions as claimed.

As to claim 8, Blase discloses lever **28**.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 2 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blase.

Blase discloses the claimed invention except for the specific materials. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the case of Blase in the claimed material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

4. Claims 3, 4, 10, 11, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blase in view of Hui (US 6,427,833).

Regarding claims 3 and 10, Blase discloses the claimed invention except for the unitary walls.

Hui discloses that it was known in the art at the time the invention was made to form the walls of a disk case from a unitary structure folded upon itself. It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the case of Blase from a unitary structure folded upon itself as taught by Hui in order to reduce assembly time. It has been held that forming in one piece an article

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which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893).

As to claims 4 and 11, the entire compartment **13** of Blase is considered a channel that is coplanar with the channel in the ejector.

Regarding claim 20, the case of Blase-Hui, as applied to claim 3 above, discloses the claimed method by presentation.

5. Claims 5-7 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blase-Hui as applied to claims 4 and 11 above, and further in view of Gloger (US 5,676,246).

Regarding claims 5 and 12, Blase-Hui discloses the claimed invention except for the guide grooves in the top and bottom walls.

Gloger discloses guide grooves **30** in the top and bottom walls. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the case of Blase-Hui with guide grooves as taught by Gloger in order to enable the reduction in size of the ejector. Such an arrangement would reduce material costs.

As to claims 6, 7, 13, and 14, Blase-Hui-Gloger discloses the claimed invention except for the specific materials. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the case of Blase-Hui-Gloger in the claimed materials, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

6. Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gelardi et al (US 4,875,743) in view of Nichols (US 1,026,111).

Regarding claim 15, Gelardi discloses a case **18** comprising a first and second **11 & 14** sidewalls of rectangular configuration having a top wall, bottom wall, rear wall, and opening as claimed (see Figure 5), and a plurality of ejector **22** with a rear arm and front arm as claimed (see Figure 2). Gelardi merely lacks the plurality of channels on the top and bottom walls.

Nichols discloses that it was known in the art to provide channels in the walls of a case in order to securely separate the disks. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the case of Gelardi with separator channels as taught by Nichols in order to protect the disks from damage.

As to claim 16, Gelardi-Nichols discloses the claimed invention except for the claimed material. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the case of Gelardi-Nichols in the claimed material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

7. Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gelardi-Nichols as applied to claim 15 above, and further in view of Hui.

Gelardi-Nichols discloses the claimed invention except for the unitary walls.

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Hui discloses that it was known in the art at the time the invention was made to form the walls of a disk case from a unitary structure folded upon itself. It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the case of Gelardi-Nichols from a unitary structure folded upon itself as taught by Hui in order to reduce assembly time. It has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893).

As to claims 18 and 19, Gelardi-Nichols-Hui discloses the claimed invention except for the claimed material. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the case of Gelardi-Nichols-Hui in the claimed material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. *Giovinazzi* and *Lew et al* disclose ejecting cases.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 703-305-8321. The examiner can normally be reached on Mon-Fri, 9:30 AM - 6:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Greg Pickett
Examiner
30 September 2004


Mickey Yu
Supervisory Patent Examiner
Group 3700